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**D E C I S I O N**  
**of 22 April 1997**

**Case Number:** T 0327/92 - 3.3.4

**Application Number:** 84106652.5

**Publication Number:** 0132565

**IPC:** B32B 27/08

**Language of the proceedings:** EN

**Title of invention:**

Oriented film laminates of polyamides and ethylene vinyl alcohol

**Patentee:**

ALLIEDSIGNAL INC.

**Opponent:**

Wolff Walsrode AG

**Headword:**

Oriented film laminates of polyamides and ethylene vinyl alcohol/ALLIEDSIGNAL INC.

**Relevant legal provisions:**

EPC Art. 54, 56, 99, 113, 123

EPC R. 55(c), 67

**Keyword:**

"Jurisdiction of Board of Appeal to consider opposition grounds on appeal where patent revoked by first instance"

"Novelty - main request (no) - auxiliary request (yes)"

"Inventive step auxiliary request (yes)"

"Substantial procedural violation (no)"

"Refund of appeal fee (no)"

**Decisions cited:**

G 0001/92, G 0002/88, T 0273/92

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**Catchword:**

Where a patent has been revoked by the Opposition Division, then on appeal the Board of Appeal is entitled to consider all material in the opposition on all grounds originally alleged, even where the opponent no longer opposes the grant of a patent and the conclusion of the Board on a particular ground differs from that of Opposition Division (Reasons section 1).

An intermediate product which exists only for some sixty seconds before being further processed, can destroy novelty of a claim where the intermediate product meets all the technical characteristics required by the claim (Reasons section 2.2).

Reliance by the Opposition Division at oral proceedings on a document originally cited in the opposition against a dependent claim only, as closest prior art against an amended main claim, does not amount to a substantial procedural violation where patentee had the opportunity at oral proceedings to comment (Reasons section 5).

**Case Number:** T 0327/92 - 3.3.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.4**  
**of 22 April 1997**

**Appellant:** ALLIEDSIGNAL INC.  
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**Representative:** Brock, Peter William  
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**Respondent:** Wolff Walsrode AG  
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**Representative:** Hansen, Bernd, Dr. Dipl.-Chem.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 10 February 1992  
revoking European patent No. 0 132 565 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** U. M. Kinkeldey  
**Members:** D. D. Harkness  
S. C. Perryman



## Summary of Facts and Submissions

- I. European patent No. 0 132 565 having eight claims relating to oriented film laminates of polyamides and ethylene vinyl alcohol was granted, following an application No. 84 106 652.5, with eight claims of which claims 1 and 8 were independent. The claims read as follows:
- "1. An expanded film laminate comprising a polyamide layer and a layer of ethylene vinyl alcohol copolymer characterised in that the laminate is expanded to an area of up to 4 times the original area, by drawing it to a draw ration of from 1.5:1 to 4:1 in at least one direction.
  2. A laminate according to claim 1 characterised in that the ethylene vinyl alcohol layer is adjacent to the polyamide layer.
  3. A laminate according to claim 1 or 2 characterised in that the laminate is biaxially orientated.
  4. A laminate according to any of claims 1 to 3 characterised in that the polyamide is polyepsiloncaprolactam.
  5. A laminate according to any one of claims 1 to 4 characterised in that a layer comprising a blend of polyamide and the ethylene vinyl alcohol is interposed between the layer of ethylene vinyl alcohol copolymer and the layer of polyamide.

6. A laminate according to any one of claims 1 to 5 characterised in that the laminate is a coextruded laminate.
7. A laminate according to any one of claims 1 to 6 characterised in that the film laminate is embossed.
8. A method of improving the barrier properties of a film laminate comprising at least one layer of polyamide and at least one layer of ethylene vinyl alcohol copolymer characterised in that the area of the laminate is expanded to an area which is up to 4 times the original area by drawing the laminate to a draw ration of from 1.5:1 to 4:1 in at least one direction."

II. Notice of opposition was filed on the grounds that the subject-matter of the patent was not novel and not inventive, (Articles 100(a), 54 and 56 EPC).

III. At oral proceedings before the Opposition Division the patentee provided a new main request and two auxiliary requests each having a single independent claim respectively. Claim 3 in each of the auxiliary requests was deleted by the patentee after objection by the Opposition Division. The main claim of each request read as follows:

"1. An expanded film laminate comprising a polyamide layer and a layer of ethylene vinyl alcohol copolymer characterised in that the laminate is expanded to an

area of up to 4 times the original area by monoaxially drawing it at a draw ratio of from 1.5 : 1 to 4 : 1."

"1. An expanded film laminate comprising polyamide layers and a layer or layers of ethylene vinyl alcohol copolymer, the layer of ethylene vinyl copolymer, or each layer of ethylene vinyl alcohol copolymer, having a polyamide layer on each face thereof characterised in that the laminate is expanded to an area of up to 4 times the original area, by monoaxially drawing at a draw ratio of from 1.5 : 1 to 4 : 1."

"1. A method of improving the barrier properties of a film laminate comprising polyamide layers and a layer or layers of ethylene vinyl alcohol copolymer the layer of ethylene vinyl alcohol copolymer, or each layer of ethylene vinyl alcohol copolymer, having a polyamide layer on each face thereof, characterised in that the area of the laminate is expanded to an area which is up to 4 times the original area by monoaxially drawing the laminate at a draw ratio of from 1.5 : 1 to 4 : 1."

IV. The Opposition Division revoked the patent as in its opinion all the requests related to non-inventive subject-matter in the light of documents:

(1) JP-A-57 159 622

(6) JP-A-52 115 880

(8) DE-A-3 229 158

V. Novelty. (Article 54 EPC)

With regard to the main request the Opposition Division stated that none of the documents cited by the Opponent described a material which disclosed all the features of claim 1 and also they did not follow the Opponents argument that document (1) disclosed a laminate which anticipated the claimed laminate but which existed only for up to 60 seconds before it was laterally stretched. The intention of the disclosure of document (1) was to provide a laminate which was biaxially stretched and therefore there was no reason to interrupt the process after the first stretching had taken place. Accordingly the Opposition Division did not regard the laminate of the citation to have been made available to the public as it had not been isolated before being further treated by stretching and its properties had not been investigated.

In respect of the two auxiliary requests their independent claims were seen as being more restricted in their scope than claims 1 and 7 of the main request and therefore they also related to novel subject-matter.

VI. Inventive step. (Article 56 EPC)

Document (6) disclosed a process for producing a film having excellent gas impermeability and mechanical strength. This was achieved by biaxially stretching a film comprising a layer of polyamide and a layer of EVOH (ethylene vinyl alcohol) copolymer. This laminate thus differed from the claimed mono-axially stretched laminate in that it has been biaxially stretched, the citation did not give a specific draw ratio.

Document (8) disclosed a laminate having a layer which comprised a blend-mixture of polyamide and EVOH copolymer and taught that films of EVOH were difficult to process and orientate because they were brittle. This difficulty was solved by blending polyamide and EVOH copolymer together. Also it was indicated that a layer of polyamide may be adjacent to the mixed layer of polyamide and EVOH. Further it was disclosed that polyamide should only be stretched to a draw ratio of 4:1 in order to avoid damage and that a suitable laminate would be obtained if stretching were carried out in one direction only.

Therefore it was obvious that the laminates of document (6) could be mono-axially stretched but not beyond that given ratio. Document (8) therefore suggested that difficulties may arise when stretching the EVOH copolymer layers of the laminate of document (6). The results obtained from the comparative tests filed on 29 January 1991 were not unexpected and did not support inventive step. Independent claims 1 and 7 of the main request therefore related to obvious subject-matter as was evident from a combination of documents (6) and (8). Those claims dependent upon claims 1 and 7 were also not allowable.

The Opposition division did not accept the patentee's argument that document (8) led away from the subject-matter of claim 1 because it required a mixture of polyamide and EVOH in one layer, biaxial stretching was used, and it was surprising that a laminate which had been stretched in only one direction had the same

or better properties than those of a biaxially stretched laminate.

The first auxiliary request was not inventive as the feature by which it differed from the main request, namely that the EVOH layer was sandwiched between two polyamide layers was known from document (8).

The second auxiliary request also did not represent inventive subject-matter as the main claim was identical with claim 8 of the first auxiliary request and failed for the same reasons.

- VII. The Appellant filed an appeal against the decision to revoke the patent, paid the appeal fee and submitted a statement of grounds which was accompanied by an affidavit from a co-inventor Mr Alfieri Degrassi. Oral proceedings were requested.
- VIII. The Respondent replied to the appeal in writing.
- IX. The Board invited both parties to oral proceedings and indicated the main issues to be discussed.
- X. The Respondent communicated by letter a complete withdrawal from the appeal proceedings and acknowledged the patentable merits of the invention.
- XI. In a further submission to the Board the Appellant filed amended first and second auxiliary requests and stated its willingness to forego oral proceedings in the event that either of the main and first auxiliary requests were to be accepted, otherwise oral

proceedings were required. The main request remained the same as that refused by the Opposition Division whilst the first auxiliary request was new and related to the use of laminates as an oxygen barrier, the main claim of the second auxiliary request being in respect of laminates per se.

XII. The Board informed the Appellant of an inconsistency in the appendancy of claim 4. It was corrected by way of deletion of the reference to claim 3 requested in the Appellant's letter of 26 November 1996. The claims of the first auxiliary request then read as follows:

- "1. Use as an oxygen barrier of an expanded film laminate comprising a polyamide layer and a layer of ethylene vinyl alcohol copolymer characterised in that the laminate is expanded to an area of up to 4 time the original area, by monoaxially drawing it to a draw ratio of from 1.5 : 1 to 4 : 1.
2. A use according to claim 1 characterised in that the ethylene vinyl alcohol layer is adjacent to the polyamide layer.
3. A use according to claim 1 or 2 characterised in that the polyamide is polyepsilon-caprolactam.
4. A use according to claim 1 characterised in that a layer comprising a blend of polyamide and the ethylene vinyl alcohol is interposed between the layer of ethylene vinyl alcohol copolymer and the layer of polyamide.

5. A use according to any one of claims 1 to 4 characterised in that the laminate is a coextruded laminate.
6. A use according to any one of claims 1 to 5 characterised in that the film laminate is embossed.

XIII. In the written submissions the Appellant contended that the Board did not have jurisdiction to reopen the alleged lack of novelty vis-à-vis document (1). This was because the Opposition Division had correctly decided the point and there was no appeal against it. Further the Respondent and sole Opponent had withdrawn from the appeal and had agreed the patentable merits of the invention, accordingly the opponent's allegations about lack of novelty were withdrawn. The Appellant did not wish this issue to be reopened since it had already been correctly decided.

None the less the Appellant argued that the subject-matter of each of the requests was novel having regard to document (1), in particular, that of the main request for the reasons given by the Opposition Division, that of the first auxiliary request because there was no suggestion in the citation to use a mono-axially drawn film for its oxygen barrier properties, and that of the second auxiliary request because there was no disclosure in the citation of a sandwich laminate as claimed.

The jurisdiction of the Appeal Board was again questioned in respect of inventive step. The Appellant

pointed out that only document (6) or a combination thereof with (8) could be considered, and again indicated that the Respondent had acknowledged patentable merit for the main request.

With regard to the determination of inventive step the Appellant was of the opinion that document (6) disclosed the right combination of layers for the main and first auxiliary requests however it contraindicated any stretching conditions different from the simultaneous biaxial stretching which it required. The citation specifically warned against sequential stretching and therefore also against monoaxial stretching. Also the degree of biaxial stretching proposed by this prior art was much greater, ie., 9 or 16 fold in the examples, than that required by the opposed patent. In application of the problem-solution approach to inventive step there was nothing in document (6) which allowed for or suggested changing its features to those of the opposed patent.

Document (8) was concerned with a blend of EVOH and polyamide which was an entirely different material from the polyamide-EVOH laminates and there was nothing in the citation which dealt with the particular problems of such a laminate nor did it suggest how to improve them. There was no suggestion that one should add to the EVOH-polyamide blend both a layer of EVOH and a layer of polyamide. From the problem-solution point of view this citation did not represent the correct starting point in respect of any of the requests nor did it indicate that the defined combination of layers when subjected to monoaxial drawing in the narrow range specified would give the advantages of the invention.

In the Appellant's view there was nothing in documents (6) and/or (8) which suggested that a skilled person could or would be able to perform the invention of the opposed patent. Further the data which had been filed were unchallenged by the Respondent and clearly showed that monoaxial stretching gave better permeability resistance than biaxial stretching. The subject-matter of the main, first and second auxiliary requests was inventive for these reasons and inventive step for the second auxiliary request was further supported by the fact that no citation provided a sandwich construction as claimed nor were the advantages thereof suggested by the prior art.

A gross procedural violation was alleged by the Appellant and a request for refund of the appeal fee was made.

The basis for this lay in the late mention by the

Opposition Division at oral proceedings of document (8). Essentially the Appellant stated that this document was not relied on either in the notice of opposition or in the written submissions thus this was contrary to Rule 59 EPC. At no time until during the oral proceedings was the document alleged to form part of the extent of the opposition against claim 1 as it had only been previously referred to in connection with original claim 5. The reliance upon this citation in order to attack claim 1 constituted new facts or evidence in support of the opposition against said claim. Thus Article 99(1) and Rule 55(c) EPC had been contravened. Although the patentee had been given a brief adjournment during oral proceedings to review the document this did not in the Appellant's opinion give the patentees an opportunity to present their comments, which opportunity was not sufficient for the patentees to make a considered technical response. Accordingly Article 113(1) EPC had not been complied with. Whilst Article 114 EPC allowed the Opposition Division to examine an opposition more broadly this article did not override the requirement of Article 113(1) EPC that the decision can only be based on grounds and evidence on which the patentee has had an opportunity to present arguments.

- XIV. The Appellant requests that the decision under appeal be set aside and the patent be maintained on the basis of the main request, or the first or second auxiliary request filed on 5 November 1996 with the correction to claim 4 filed on 26 November 1996. A reimbursement of the appeal fee is requested.

## Reasons for the Decision

1. *Jurisdiction of the Appeal Board*
  - 1.1 The Appellant has expressed the view that because the Respondent has withdrawn from the appeal proceedings and recognised the patentable merits of the invention claimed in the patent then in making its decision the Board has no jurisdiction to reopen the question of novelty in the light of the disclosure of document (1).
  - 1.2 Also document (8), relevant to inventive step, should according to the Appellant be disregarded on the basis of the alleged procedural violation, thus only document (6) would remain.
  - 1.3 The Board disagrees with this view. In the present case the patent was revoked so there is nothing the Board can refuse the Appellant which the Opposition Division has not already denied it. The doctrine of *reformatio in peius* cannot be extended to apply separately to each point decided by the Opposition Division. Rather the Board of Appeal must examine all the material before the Opposition Division, whether introduced by the opponent or the Opposition Division, as to its relevance to the grounds of invalidity raised in the opposition, and then decide for itself on the requests made on appeal. The Board should only set aside the decision of the Opposition Division if the patent can be maintained on the basis of a request put forward on appeal that meets the requirements of the European Patent Convention.

1.4 The overly formalistic approach advocated by the appellant would lead to situations where the Board, though convinced that the decision to revoke was justified on the material before the Opposition Division in relation to the grounds alleged, would be obliged to grant the patent merely because its reasoning on each document was not identical to that of the Opposition Division.

2. *Main request*

2.1 Given the above conclusion by the Board in section 1 the Board has to examine the claims put forward as to all the requirements of the EPC raised in the opposition.

2.2 *Novelty, (Article 54 EPC)*

2.2.1 The product of the process of document (1) comprised a laminate which resulted directly from the process of laminating three defined layers together, these being polyamide, EVOH and an ionomer resin layer, which laminate was stretched up to 2.5 times its length in one direction and then, within a short time, further stretched at right angles to this direction. In the process a monoaxially stretched laminate existed, at least for 60 seconds.

2.2.2 In this instance the described preparation of the laminate destroys the novelty of claim 1. Claim 1 does not require as a technical feature that it be recognized that the laminate has any particular

properties other than the laminate composition and stretching which are described in document (1).

2.2.3 It should be noted that the reason that the Board reaches a different conclusion to the Opposition Division does not turn on any different assessment of the technical content of document (1), but only on a different interpretation of what technical features the claim under consideration requires to be present. Claim 1 of this request has no feature relating to any properties that the laminate is required to have, whether oxygen barrier properties or any others. Accordingly it is, in the Board's judgement, not significant for the assessment of the novelty of this claim that the skilled person has no reason to interrupt the manufacturing process described in document (1) and investigate the properties of the monoaxially stretched manufacturing intermediate. Only by modifying the claim to require, as a technical feature, that use of the laminate be as a gas barrier, could novelty over the disclosure of document (1) be created.

2.2.4 Claim 1 thus is not allowable under Article 54 EPC, and thus the main request as a whole is not allowable.

### 3. *First auxiliary request*

#### 3.1 *Allowability, (Article 123(2) and (3) EPC)*

3.1.1 The main claim of this request is drafted in the form of a "use as an oxygen barrier" of the laminates which were claimed even more broadly per se in claim 1 as

granted. The Board considers that the change in wording from "drawing ....in at least one direction" of the claim as granted, to the present "monoaxially drawing" excludes from this use claim the use of layers which have biaxially drawn.

- 3.1.2 This new request complies with Article 123(2) EPC because the use of the laminates as an oxygen barrier was disclosed in the application as originally filed (page 7 line 27).
- 3.1.3 The protection conferred by this new request relating to use claims has not been extended beyond that of the product claim 1 of the granted patent because the claim to the laminate only when it is being used for a particular purpose comprises a narrower protection than that of a claim to the laminate per se which claim covers all uses. Accordingly the requirements of Article 123(3) EPC are also met.
- 3.1.4 The above conclusion follows the reasoning of the Enlarged Board of Appeal Decision G 2/88 OJ 1990, 93 at points 4 and 5 of the reasons which discussed the allowability of change of category from a claim to a compound to a claim to the use of that compound.
- 3.2 *Novelty (Article 54 EPC)*
  - 3.2.1 Document (1) discloses a laminate of the type for which the use as an oxygen barrier is claimed, whereby the monoaxially stretched laminate is further processed into a biaxially stretched laminate within a short time of having made the monoaxially stretched laminate.

There is in this document no teaching that this laminate would be used for any purpose other than manufacture of the biaxially stretched product. The disclosure of a laminate per se does not imply any particular use thereof and accordingly the use as an oxygen barrier of the subject matter of the main claim of this request is novel vis-à-vis this prior art.

- 3.2.2 This conclusion is in agreement with point 3 of the reasons in Enlarged Board of Appeal Decision G 1/92 (OJ EPO 1993, 277) where it was observed that a commercially available product per se does not implicitly disclose anything beyond its composition or internal structure, thus extrinsic characteristics revealed when the product is exposed to specifically chosen outside conditions, eg., to provide a particular effect or result, therefore point beyond the product per se as they are dependant on deliberate choices being made.
- 3.2.3 Document (6) relates to biaxially stretched laminates made by simultaneously stretching in both the longitudinal and lateral directions. Accordingly a monoaxially stretched laminate was not disclosed in this document and the use of such a laminate for any purpose was also not described.
- 3.2.4 The disclosure of document (8) concerned films made from a blend of polyamide with EVOH and also laminates in which this film is laminated with one or two further polymer films, however a laminate comprising a combination of a polyamide film layer and an EVOH film layer was not described. Accordingly the subject-matter

of the first auxiliary request is novel over this prior art.

3.3 *Inventive step, (Article 56 EPC)*

3.3.1 In view of the additional prior art cited during the opposition, the problem to be solved must be stated in different terms than in the original application. A reasonable formulation, not involving hindsight, is to provide a laminate for use as an oxygen barrier comprising both a polyamide and an EVOH based layers. This problem has, taking into account the information in Mr. Degrassi's affidavit, been solved by the use of the laminate now the subject of claim 1 of this request.

3.3.2 In relation to this problem, document (1) although disclosing the laminates per se, is not a suitable starting point as it is not concerned with use as an oxygen barrier. This is in agreement with the established case law of the Boards of Appeal confirmed by decision T 273/92 of 18 August 1993 according to which a document may not qualify as closest prior art to an invention merely because of similarity in the composition of the products, its suitability for the desired use of the invention also had to be described.

3.3.3 The films described in document (8) are to be used as oxygen barriers. The laminates used contain a layer of a blend of polyamide with EVOH, and a layer of polyamide, and uses monoaxial stretching. It is a possible starting point for a problem-solution approach with the above stated problem. However as the whole

essence of the teaching of this document is to overcome the problems of the brittleness, poor workability and sensitivity to moisture of EVOH film while retaining various desirable properties, including good gas barrier characteristics, and as the solution proposed is to use a layer of EVOH was blended with a proportion of polyamide in weight percent 90 to 10 EVOH with 10 to 90 polyamide, this document, if anything, points away from using a monoaxially stretched layer of unblended EVOH. The description referred to mono- and bi-axial stretching, the latter being preferred. However, insofar as stretching was discussed in document (8), the information followed the acknowledged conventional line that the greater the degree of stretching the more orientation was created in the film or laminate and the better would be the gas barrier properties, and would give the skilled person no reason to think that a layer of EVOH stretched only monoaxially would be suitable.

3.3.4 For the stated problem, document (6) which is concerned with a laminate made from polyamide and EVOH layers for use as a gas barrier would also be a suitable starting point. However document (6) teaches that the acknowledged problems of EVOH layers can be overcome by stretching it simultaneously in two different directions. It contains no hint that the stated problem could be solved by simple monoaxial stretching of the EVOH and polyamide layers.

3.3.5 The specific disclosure of document (6) indicated that a biaxially stretched laminate was more uniform and had a higher degree of crystallinity upon which gas barrier properties depend than did a monoaxially stretched

laminate of the same material. At page 6 last two lines to page 7 line 1 it was categorically denied that a sequential stretching process can give a uniformly stretched product and therefore it was concluded that monoaxial stretching would not lead to acceptable results. The technical teaching of this document is quite contrary to what is proposed by the patent in suit.

3.3.6 The affidavit from Mr Degrassi provided evidence that laminates of the defined composition when monoaxially stretched did have better oxygen gas barrier properties than biaxially stretched laminates and this represented an unexpected advantage particularly as the examples of biaxial stretching show a nine-fold increase in area after stretching whereas the monoaxially stretched laminates only exhibited a three-fold increase. This would indicate according to prior art teaching that the increased crystallinity resulting from the nine-fold increase in area of the biaxially stretched laminate would lead to a better gas barrier effect than that of the laminate of the invention, however that is not the case.

3.3.7 No combination of the cited documents would lead a skilled person to expect the claimed use to work, as they all show the same prejudice against such use being possible.

3.3.8 The claim 1 of this request is related to a use, against which the prior art establishes a firm prejudice. As the former opponent has also acknowledged that there is invention, in the Board's view there is

no reason for denying inventive step.

3.3.9 The subject-matter of claims 2 to 6 relating to preferred features and dependent upon claim 1 consequently is also inventive, and the request as a whole can be allowed.

4. *Second auxiliary request*

4.1 In view of the above decision to allow the first auxiliary request the second auxiliary request need not be considered.

5. *Procedural violation, (Articles 99 and 113 and Rule 55(c) EPC) - Refund of appeal fees (Rule 67 EPC)*

5.1 Document (8) was first introduced into the proceedings in the statement of grounds filed in support of the opposition, and therefore the Appellant's attention was drawn to this document at the earliest opportunity. Although this document was not listed on page 2 of the statement as a "citation" it was specifically indicated as being relevant in respect of claim 5.

5.2 Claim 5 was dependent on claim 1, and thus its subject matter fell within the scope of claim 1 as filed. Thus a document alleged to render claim 5 obvious, would also render claim 1 obvious. The reason for not citing it against claim 1 appears to have been that the opponent was already relying on other prior art closer to the claim 1 then on file and destroying its novelty.

5.3 In such a situation the patentee must however be aware

that when he files more restricted claims, the Opposition Division may react by relying more on other documents already in the opposition file, and be prepared to meet objections based on such documents put to him at the oral proceedings.

5.4 In this case the Opposition Division did put objections to the patentee at the oral proceedings based on document (8) and allowed a break in the oral proceedings in order for the parties to consider their arguments on this document. The patentee was thus dealing with a document which was always part of the opposition, and had further opportunity to consider this document at the oral proceedings. The requirements of Article 113(1) EPC were thus met in relation to the objection based on this document. This is confirmed by the decision of the Opposition Division reciting arguments presented by the Appellant in respect of document (8), which indicates that any surprise experienced by the Appellant was not such as to make him unable to argue the point. If the Opposition Division and the opponent is to be expected by a patentee to consider sets of claims presented at or shortly before the oral proceedings, then the patentee in his turn must expect to be asked to defend the claims against objections raised at the oral proceedings based on all citations on file.

5.5 Thus as the Appellant had the opportunity to comment on the Opposition Division's changed line of objection at the oral proceedings before the division, the Board can see no substantial procedural violation in the Opposition Division's way of proceeding, and thus no

basis for reimbursement of the appeal fee pursuant to Rule 67 EPC.

- 5.6 Accordingly the request for a refund of the appeal fee is refused.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is referred back to the first instance with the order to maintain the patent on the basis of the first auxiliary request filed on 5 November 1996 with the amendment to claim 4 received on 26 November 1996, and a description to be adapted.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:      The Chairwoman:

A. Townend

U. Kinkeldey